

REMARKS

This Response is submitted in reply to the Office Action dated February 22, 2010. Claim 1 has been amended for clarity. Claims 2, 5, 13, 17, 18 and 33 to 34 were previously canceled. Claims 15 to 16 and 19 to 32 stand withdrawn. No new matter has been added by these amendments. Please charge deposit account number 02-1818 any fees which are due in connection with this Response

The Office Action rejected Claims 1, 3, 4 and 6 to 10 under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent Application Publication No. 2002/0132660 to Taylor ("Taylor"). Applicant respectfully disagrees with this rejection for at least the following reasons.

The Abstract of Taylor discloses:

[a] method for wagering on a gaming device where players purchase time on the device as opposed to an individual game. Within the pre-purchased time period, players are allowed to play as many individual games as possible to maximize their returns. In one preferred embodiment, winnings are retained and accumulated without requiring additional wagers. Players may also win or purchase additional time or make additional wagers during the pre-purchased time period.

Amended independent Claim 1 is directed to a method of operating a gaming system, the method including, amongst other elements, at a first point in time, causing at least one processor of a wagering game device to execute a plurality of instructions to: (i) determine a current time, and (ii) determine a reference time, wherein, at the first point in time, the determined reference time is different than the determined current time. The method of operating a gaming system of amended independent Claim 1 also includes, at a second, different point in time, causing the at least one processor to execute the plurality of instructions to: (i) determine that the second point in time has a predetermined relationship to the determined reference time, and (ii) in response to the determination that the second point in time has the predetermined relationship to the determined reference time, cause at least one display device to display a first play of a bonus game, the first play of the bonus game being displayed distinct and independent from any outcome being generated during any play of any game and the first play of the bonus game having a first average expected payout which is based, at least in part, on the second point in time having the predetermined relationship to the determined reference time; and at a third, different point in time, causing the at least one processor

to execute the plurality of instructions to: (i) determine that a triggering event has occurred, the triggering event occurring independent of the third point in time, and (ii) cause the at least one display device to display a second, different play of the bonus game, the second, different play of the bonus game having a second, different average expected payout.

Page 3 of the Office Action stated that:

Taylor teaches a method of operating a gaming system, said method comprising...(b) at a second, different point in time [0057], causing the at least one processor to execute the plurality of instructions to: (i) determine that the second point in time has a predetermined relationship to the determined reference time [0057]; and (ii) cause at least one display device to display a first play of a bonus game (extended time), said first play of the bonus game having a first average expected payout which is based, at least in part, on the second point in time having the predetermined relationship to the determined reference time [0057-0058]; and (c) at a third, different point in time, causing the at least one processor to execute the plurality of instructions to: (i) determine a triggering event has occurred, the triggering event occurring independent of the third point in time [0060]; and (ii) cause the at least one display device to display a second, different play of the bonus game, said second, different play of the bonus game having a second, different average expected payout [0060].

Applicant respectfully disagrees because the Office Action appears to have improperly picked and combined separate embodiments from Taylor to form the basis of this rejection.

The Federal Circuit expressly explained in Net MoneyIN, Inc. v. VERISIGN, Inc., No. 07-1565 (Fed. Cir. 10/20/2008), that "unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. §102." The Federal Circuit also expressly explained in Net MoneyIN, Inc., that "it is not enough that the prior art reference discloses part of the claimed invention, which an ordinary artisan might supplement to make the whole, or that it includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention See In re Arkley, 455 F.2d 586, 587 (CCPA 1972). ("[T]he [prior art] reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in

the art to the [invention] without any need for picking, choosing, and combining various disclosures not directly related to each other by teachings of the cited reference.)”.

In this case, the Office Action appears to have relied on a first alternative embodiment of Taylor in which a scatter pay of 3 or more of a specified symbols landing anywhere onscreen triggers extended play time (see Taylor paragraph [0057]) in combination with a second alternative embodiment of Taylor in which a scatter pay of 3 or more special symbols appearing anywhere onscreen in the base game triggers a second screen feature game (see Taylor paragraph [0060]) to form the basis of this rejection. The elements of these different embodiments of Taylor are not arranged or combined in Taylor in the same way as the method of operating a gaming system of independent Claim 1. Additionally, Taylor does not include any teaching that would direct those skilled in the art to the method of operating a gaming system of independent Claim 1 without any need for picking, choosing, and combining various disclosures not directly related to each other.

Applicant submits that if the Office Action relies on the embodiment of Taylor in which a scatter pay of 3 or more of a specified symbols landing anywhere onscreen triggers extended play time for anticipating the method of operating a gaming system of independent Claim 1, then Taylor does not anticipate, at a third, different point in time, determining that a triggering event has occurred, the triggering event occurring independent of the third point in time, and causing the at least one display device to display a second, different play of the bonus game, the second, different play of the bonus game having a second, different average expected payout. That is, in this embodiment of Taylor, because the triggering event occurs when the pre-purchased time period expires, as discussed in more detail below, the triggering event (which is interpreted by the Office Action to be the expiration of the pre-purchased time period) does not occur independent of a third point in time. Additionally, this embodiment of Taylor does not appear to include two different plays of the bonus game, each different play of the bonus game having a different average expected payout. On the other hand, the method of operating a gaming system of independent Claim 1 includes, amongst other elements, at a third, different point in time, causing the at least one processor to execute the plurality of instructions to: (i) determine that a triggering event has occurred, the triggering event occurring independent of the third point in time, and

(ii) cause the at least one display device to display a second, different play of the bonus game, the second, different play of the bonus game having a second, different average expected payout.

Additionally, Applicant submits that if the Office Action relies on the embodiment of Taylor in which a scatter pay of 3 or more special symbols appearing anywhere onscreen in the base game triggers a second screen feature game for anticipating the method of operating a gaming system of independent Claim 1, then Taylor does not anticipate at a second, different point in time, determining that the second point in time has a predetermined relationship to the determined reference time, and causing at least one display device to display a first play of a bonus game, the first play of the bonus game having a first average expected payout which is based, at least in part, on the second point in time having the predetermined relationship to the determined reference time. That is, this embodiment of Taylor does not include two different plays of the bonus game, each different play of the bonus game having a different average expected payout. On the other hand, the method of operating a gaming system of independent Claim 1 includes, amongst other elements, at a second, different point in time, causing the at least one processor to execute the plurality of instructions to: (i) determine that the second point in time has a predetermined relationship to the determined reference time, and (ii) cause at least one display device to display a first play of a bonus game, the first play of the bonus game having a first average expected payout which is based, at least in part, on the second point in time having the predetermined relationship to the determined reference time.

Nevertheless, Applicant amended certain of the claims to clarify that the first play of the bonus game is displayed distinct and independent from any outcome being generated during any play of any game. Applicant submits that Taylor does not anticipate at a second, different point in time, causing the at least one processor to execute the plurality of instructions to: (i) determine that the second point in time has a predetermined relationship to the determined reference time, and (ii) in response to the determination that the second point in time has the predetermined relationship to the determined reference time, cause at least one display device to display a first play of a bonus game, the first play of the bonus game being displayed distinct and independent from any outcome being generated during any play of any game and the first play of the

bonus game having a first average expected payout which is based, at least in part, on the second point in time having the predetermined relationship to the determined reference time.

Paragraph [0057] of Taylor discloses:

[i]n one alternative embodiment of the present invention, the game is provided with a feature that offers additional play time. For example, the payable includes a "scatter pay" that triggers extended play time for 3 or more of a specified symbol landing anywhere onscreen. The extended play time may typically pay 10 seconds for 3 of the symbols, 20 seconds for 4 of the symbols and 30 seconds of additional play time for 5 of the symbols. The extended play time is accumulated on a separate, extended play meter and, upon the expiration of the originally pre-purchased time period, is posted to the game clock and used immediately without any further action by the player.

Applicant submits that the Office Action interprets the extended play of Taylor as the first play of the bonus game of the method of independent Claim 1. Additionally, Applicant submits that the Office Action interprets the expiration of the originally pre-purchased time period of Taylor as the second point in time having a predetermined relationship to the determined reference time of the method of independent Claim 1. In Taylor, extended play time is provided based on one or more designated outcomes occurring in association with a play of a game (e.g., an outcome of 3 specified symbols landing anywhere onscreen typically pays 10 seconds, see Taylor paragraph [0058]). Thus, in Taylor, if zero of the outcomes generated in association with the play of the game are associated with extended play time, zero extended play is provided to the player. While Taylor includes the second point in time having a predetermined relationship to the determined reference time (i.e., the point in time when the pre-purchased time period expires), if zero extended play time is provided to the player in Taylor, the player does not experience any extended play at the expiration of the originally pre-purchased time period (i.e., no interpreted first play of the bonus game). Thus, Taylor does not anticipate at a second, different point in time, causing the at least one processor to execute a plurality of instructions to determine that the second point in time has a predetermined relationship to the determined reference time, and in response to the determination that the second point in time has the predetermined relationship to the determined reference time, cause at least one display device to display a first play of a bonus game, the first play of the bonus game being displayed

distinct and independent from any outcome being generated during any play of any game.

On the other hand, the method of operating a gaming system of amended independent Claim 1 includes, amongst other elements, at a second, different point in time, causing the at least one processor to execute the plurality of instructions to: (i) determine that the second point in time has a predetermined relationship to the determined reference time, and (ii) in response to the determination that the second point in time has the predetermined relationship to the determined reference time, cause at least one display device to display a first play of a bonus game, the first play of the bonus game being displayed distinct and independent from any outcome being generated during any play of any game. For at least these reasons, Applicant respectfully submits that amended independent Claim 1 is patentably distinguished over Taylor and is in condition for allowance.

Claims 3, 4, and 6 to 10 depend directly or indirectly from independent Claim 1 and are also allowable for the reasons given with respect to independent Claim 1 and because of the additional features recited in these claims.

The Office Action rejected Claims 11, 12 and 14 under 35 U.S.C. §103(a) as being unpatentable over Taylor in view of U.S. Patent No. 5,655,961 to Acres et al. ("Acres"). Applicant respectfully disagrees with this rejection for at least the following reasons.

Regarding Claims 11, 12 and 14, page 6 of the Office Action stated that:

Taylor is silent on player tracking capabilities...Acres et al. teaches improved player tracking by recording each and every machine transaction including time of play, machine number, duration of play, coins in, coins out, hand paid jackpots and games played. The player tracking is conducted over the same network as the accounting data is extracted. It would be obvious to substitute Acres player tracking system into the Taylor gaming system to allow the invention to provide bonusing to certain individual players as well as during certain times.

Applicant respectfully submits that regardless of whether or not it would be obvious to substitute Acres player tracking system into the Taylor gaming system to allow the invention to provide bonusing to certain individual players as well as during

certain times, Taylor does not anticipate at a second, different point in time, causing the at least one processor to execute a plurality of instructions to determine that the second point in time has a predetermined relationship to the determined reference time, and in response to the determination that the second point in time has the predetermined relationship to the determined reference time, cause at least one display device to display a first play of a bonus game, the first play of the bonus game being displayed distinct and independent from any outcome being generated during any play of any game.

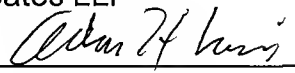
Acres does not cure this deficiency. Thus, the method of operating a gaming system resulting from the combination of Taylor and Acres does not anticipate or render obvious (without the benefit of improper hindsight reconstruction) at a second, different point in time, causing the at least one processor to execute a plurality of instructions to determine that the second point in time has a predetermined relationship to the determined reference time, and in response to the determination that the second point in time has the predetermined relationship to the determined reference time, cause at least one display device to display a first play of a bonus game, the first play of the bonus game being displayed distinct and independent from any outcome being generated during any play of any game.

On the other hand, the method of operating a gaming system of Claims 11, 12 and 14 each include, amongst other elements, at a second, different point in time, causing the at least one processor to execute a plurality of instructions to determine that the second point in time has a predetermined relationship to the determined reference time, and in response to the determination that the second point in time has the predetermined relationship to the determined reference time, cause at least one display device to display a first play of a bonus game, the first play of the bonus game being displayed distinct and independent from any outcome being generated during any play of any game. For at least these reasons, Applicant submits that Claims 11, 12 and 14 are each patentably distinguished over Taylor and Acres and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for allowance and is courteously solicited. If the Examiner has any questions related to this Response, Applicant requests that the Examiner contact the undersigned.

Respectfully submitted,

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